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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,029	10/11/2000	Terence F. Kelly	067808-0114	5931

22922 7590 03/11/2003

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EXAMINER

MCELHENY JR, DONALD E

ART UNIT PAPER NUMBER

2862

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/686,029

Applicant(s)

KELLY ET AL.

Examiner

Donald E. McElheny, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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1. The drawings are objected to for reasons set forth by the Office Draftsperson on form PTO-948. Correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim is dependent upon itself, thus indefinite in what proper combination is intended. Therefore it will not be further treated on the merits.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application

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published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-67 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Burfeind et al. (6,360,172 B1).

Burfeind et al. teach a subscriber information system which provides individuals with tailored personal preferences (e.g. profiles) controls over the specific information in which they are interested in receiving. That receipt may be in a variety of modes, including email notification on a multimedia computer via the Internet of events and information they are interested, where that information is taught may include weather

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related such as alerts per their user criteria and the user directed to further specific information on the topic at specific Internet sites. Thus a user has an option to be notified in a mode of via email, receive a brief description of some prescribed data/event, and retrieve further detailed information in a controlled mode that generates and/or supplies the user an Internet web page with the criteria data the user had set forth in his prior preferences. While the reference may not use the identical language as applicants, nor teach all specific Internet operation details such as hyperlinks operations and web page support for the presentation of the data that the user ultimately can view, such differences are either inherent in such a prior art mode of Internet server system or of such routine and notoriously well known design choice by those of ordinary skill in the art that they do not constitute the concept of invention nor novelty. Those skilled in the art were well aware that emails could contain not only embedded text and graphic information but also hyperlinks to Internet sites that supply further (i.e. more detailed) information on a subject. Also, the fact that each subscriber/user receives a tailored email and related Internet site information compiled together per the system control criteria for data's page presentation, note that it matters not that plural users or a single user may and/or be directed elsewhere to receive such information because each is still "personalized" to meet their profile criteria -- it matters not that others may have similar interests and requests. Inherently the user supplied email message content will be a "less detailed report" than what they add by further supplied Internet information from hyperlinked web sites. Furthermore, the presentation of the weather data to the user by various criteria such as high temperatures, lows,

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graphics and any of the other claimed weather presentation graphics data content and techniques do not constitute inventive subject matter nature as such were already notoriously well known and used by weatherman and Internet weather web pages for the same purposes and also because such data is directed to descriptive non-functional/functional subject matter not constituting statutory subject matter (under PTO computer implemented invention Guidelines) in the context used and claimed, but are analogous to mere printed matter-- and Official Notice is so given of such notoriety of such weather data presentation features (see Internet pages prior art cited in applicants' own IDS statements, for example).

One item Burfeind et al. also do not go into much detail on is how their subscriber personal preferences ("user profile") is gathered or specifically created. They do mention use of Internet techniques where the user selects the criteria from a presentation of choices. Anyone of routine and ordinary skill in the Internet and computer arts was well aware that such information gathering and user selection was routinely done by "forms" pages/tables within emails and over Internet web pages, and thus details to such features as claimed are hereby stated as either being inherent within the teachings of this reference or under Official Notice as also being of such common knowledge in the art that one would have routinely considered such known techniques as an obvious design choice for presented such choices to the customer/user and gathering of their choices and preference selections.

8. Claims 1-67 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Stevens (6,404,880 B1) or

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Ford et al. (6,480,830 B1) for similar reasons as set forth supra for the Burfeind et al. rejection.

Both these patents teach information systems that supply users their preferred data content services via email, where that content can include tailored weather for their specified region(s) of interest. Note these patents discuss in more detail some of the Internet server aspects and customer/subscriber preferences gathering techniques for development of their "profiles".

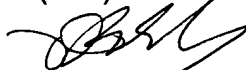
9. Other prior art is cited of pertinence in teaching additional personalized information data services that include weather related data of interest to the user, including various alternatives and specifics in data gathering, handling and presentation.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald McElheny Jr., whose telephone number is (703) 305-3894.

Fax transmissions may be directed to (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Edward Lefkowitz, can be reached at (703) 305-4816.



**DONALD E. McELHENY, JR.**  
**PRIMARY EXAMINER**